

Notice of Allowability

Application No.

09/068,377

Examiner

Stephen L. Rawlings, Ph.D.

Applicant(s)

LASKY ET AL.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

- ☒ This communication is responsive to 29 October 2004.
- ☒ The allowed claim(s) is/are 16-18 and 24.
- ☒ The drawings filed on 08 May 1998 are accepted by the Examiner.
- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

- ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
- ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
- ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
- ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

LARRY R. HELMS, PH.D.
PRIMARY EXAMINER

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with James A. Fox on December 2, 2004.

The application has been amended as follows:

Claim 24 has been amended as follows:

24. (currently amended) An antibody that specifically binds to a PST phosphatase interacting protein (PSTPIP) polypeptide of SEQ ID NO:1, wherein said antibody is not an anti-phosphotyrosine antibody.

The specification has been amended as follows:

The paragraph at page 1 beginning at line 4 has been replaced with the following:

This application is the National Stage of International Application PCT/US98/01774 filed January 30, 1998, which claims priority to U.S. Provisional Application No. 60/104,589 filed February 7, 1997, and is a continuation-in-part of U.S. Application No. 08/938,830 filed September 29, 1997, now U.S. Patent No. 6,040,437 issued March 21, 2000, which claims priority to U.S. Provisional Application No. 60/104,589 filed February 7, 1997.

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The following is an examiner's statement of reasons for allowance:

The claims are drawn to a genus of antibodies that specifically bind the PSTPIP of SEQ ID NO: 1. The specification describes this genus of antibodies as including anti-phosphotyrosine antibodies; see, e.g., Figure 6; page 4, line 32, through page 5, line 7; and page 47, line 19, through page 51, line 2.

Although the prior art teaches an antibody that specifically binds the polypeptide, namely an anti-phosphotyrosine antibody (see, e.g., Sodhi et al. and Frackelton et al., which are both of record), claim 24 deliberately excludes this species of antibody from the claimed subject matter.

The disclosure of both the genus *and* the species, which has deliberately been excluded from the claimed subject matter by the proviso exclusion of that species, is proper, since the specification, having described the whole, must necessarily have described the part remaining after the proviso exclusion of the species disclosed by the prior art. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187 (CCPA 1977); see MPEP § 2173.05(i).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on (571) 272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen L. Rawlings, Ph.D.
Examiner
Art Unit 1642

slr
December 3, 2004